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EXAMINER SHELEHEDA, JAMES R				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/515,272  
Filing Date: February 29, 2000  
Appellant(s): KINDER ET AL.

\_\_\_\_\_  
Timothy N. Trop  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 03/09/10 appealing from the Office action mailed 11/18/09.

**(1) Real Party in Interest**

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Appeal No. 2008-3135.

**(3) Status of Claims**

The following is a list of claims that are rejected and pending in the application:

Claims 12-16 and 19-21.

**(4) Status of Amendments After Final**

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

**(5) Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

**NEW GROUND(S) OF REJECTION**

Claims 12-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 12-16 recite a "computer readable medium" which is directed to non-statutory subject matter as the broadest reasonable interpretation includes covers both *transitory* (i.e. signals) and non-transitory forms.

The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals *per se* in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. See MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal *per se*, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. See *In re Nuijten*, 500 F.3d

1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and *Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101*, Aug. 24, 2009; p. 2.

A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation "non-transitory" to the claim.

#### **(7) Claims Appendix**

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

#### **(8) Evidence Relied Upon**

5,604,542	Dedrick	02-1997
6,057,872	Candelore	05-2000
US 2001/0041330 A1	Brown et al.	11-2001
6,681,393	Bauminger et al.	01-2004

#### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:  
Claims 12-15, 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick in view of Candelore and Brown.

Regarding Claim 12, Dedrick discloses an electronic system (See Figure 1) with an encoder (14), transmitter (80), receiver (82) and decoder (84). As is well known in the art, such digital computing devices comprise a medium for storing instructions that cause a processor to perform a function. This system performs the method of transmitting video content (Col. 2, Lines 25-28) and transmitting electronic advertisements (Col. 2, Lines 10-14) comprising graphics (Col. 2, Line 19) in the vertical blanking interval of the video signal (Col. 2, Lines 20-33). The advertisement may be a redeemable coupon (Col. 3, Lines 2-3). Information carried in the VBI signal must be encoded such that the advertisement image is split up into packets (Col. 2, Lines 35-64). The image is subsequently delivered to a receiver one bit at a time in a serial data stream. This reads on the claimed transmitting incentive image portions (packets) of a viewer image (electronic advertisement including a redeemable coupon) over time in association with the video content (television program). In order to receive all the packets for a particular image, the user must be tuned to the channel carrying the data for a sufficient duration of time. This reads on the claimed incentive image portions accumulating depending on viewing time to form the complete image.

What is not disclosed, however, is electronically posing a question in the course of transmitting the video content to determine whether the viewer is actually watching the content and only accruing the incentive when the viewer is actually watching the content and wherein the incentive image portions correspond to complete image sections of the viewer incentive image and delaying display of the complete viewer incentive image by enabling the complete image sections to be displayed without

displaying the complete incentive image, the extent of the incomplete image that is displayed in the form of said complete image sections being dependent on the time spent viewing the video content.

In an analogous art, Candelore discloses a system for transmitting digital coupons (Col. 4, Line 63 – Col. 5, Line 5) in order to reward viewer loyalty in a cable television network (Col. 5, Line 26) based on a viewer's consumption of programming (Col. 6, Lines 27-31) wherein the system verifies that the subscriber is present and viewing a program by asking the subscriber a question and requiring the subscriber to provide interactive input (Col. 3, Lines 53-62 and Col. 12, Lines 47-56). This reads on the claimed electronically posing a question in the course of transmitting the video content to determine whether the viewer is actually watching the content and only accruing the incentive when the viewer is actually watching the content. Candelore is evidence that one of ordinary skill in the art would appreciate the ability to ensure a viewer is actually paying attention to programming before providing a reward for watching the programming. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Dedrick in view of Candelore in order to prevent viewers from gaining rewards for content they didn't actually view.

Additionally, in an analogous art, Brown discloses a method for motivating users by providing users by delaying display of a complete viewer incentive image (Fig. 12A; paragraph 128) by enabling the complete image sections to be displayed without displaying the complete incentive image (paragraph 128), the extent of the incomplete

image that is displayed in the form of said complete image sections being dependent on the time spent viewing the video content (paragraph 128). Brown is evidence that one of ordinary skill in the art would appreciate the ability to motivate users to pay more attention to content by providing positive feedback to users in the form of rewards encompassing pieces of an overall image to be earned. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Dedrick and Candelore in view of Brown in order to better motivate to pay attention and participate in the provided content.

Regarding Claim 13, Dedrick further discloses transmitting portions of a viewer incentive image (advertisement) in association with the content (television program) includes transmitting the viewer incentive image portions (packetized data) together with the television content in the program's VBI, as stated above.

Regarding Claim 14, Dedrick further discloses that transmitting video content includes transmitting video programming (television programming) together with ancillary information (VBI data, See Figures 3-5) and transmitting the viewer incentive image portions (advertisement/coupon) as part of the ancillary information (VBI data) as stated above. As is well known in the art, the VBI may contain closed captioning information as well as other embedded data.



Regarding Claim 15, Dedrick further discloses storing instructions that cause a processor-based system such as encoder (14) and transmitter (80) to progressively provide, in the form of a serialized data stream encoded in the television show's VBI, an image portion of an overall incentive image (advertisement/coupon) which may be earned by those viewers who view programming for a given amount of time as stated above in Claim 1.

Regarding Claim 19, see Claim 12 above. Dedrick further discloses a video content receiver (82) and a data decoder (84). The decoder removes the electronic advertisement from the VBI and extracts the transmitted information (Col. 3, Lines 25-28). The decoder therefore reads on the claimed ancillary content receiver. Further disclosed is a transmitter (80).

Regarding Claim 20, see Claim 13 above.

Regarding Claim 21, Dedrick, Candelore and Brown disclose a system as stated above in Claim 19. What is not disclosed, however, is that the video content and ancillary information are transmitted at separate times. Candelore further discloses a system as stated above, wherein the digital coupon information may be transmitted via a separate path from the television programming (Col. 5, Lines 53-55). This reads on the claimed video content and ancillary information being transmitted at separate times. Candelore is evidence that one of ordinary skill in the art would appreciate the ability to

use a separate transmission path for video services and digital coupon information. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the system of Dedrick in view of the PNG Specification and Candelore with the separate transmission path in order to implement a bi-directional network for interactive distribution and feedback or to provide a higher bandwidth transmission channel than VBI for the interactive advertisement information.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick in view of the PNG Specification, Version 1 and Candelore and further in view of Bauminger.

Regarding Claim 16, Dedrick in view of the PNG Specification and Candelore disclose a method as stated above in Claim 1. What is not disclosed, however, is showing the portion of an incentive image that has not yet been earned. Bauminger discloses an interactive television system for displaying advertisements (Co1. 5, Lines 21-34) and accumulating a history of users interactions (Col. 6, Lines 16-49) in order to provide a coupon or prize (Co1. 5, Lines 1-7). Bauminger further discloses displaying to the user a portion of an incentive image that has not yet been earned (See Figures 1A and 1B). Bauminger is evidence that ordinary workers in the art would recognize the benefits of prompting users with an unearned portion of an incentive, such as how many times the user is required to participate in a contest to receive a coupon (Col. 5, Lines 32-52). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Dedrick in view of the PNG Specification and Candelore with the display of an unearned portion of an incentive of Bauminger in order to increase viewer participation and consumption of advertising by

encouraging the viewer to participate in more interactive advertising content as disclosed by Bauminger (Col. 5, Lines 32-39).

#### **(10) Response to Argument**

Appellant argues that the pieces in Brown are not progressively displayed, as they are displayed at one time as a reward. In response, it is noted that Brown discloses where a feedback display will **periodically** be displayed (paragraph 128). This display would display to the viewer the current number of pieces they have earned (paragraph 128). Thus, the *next time* the feedback is displayed, it would also include any additional pieces that have been earned in the meantime. Therefore, appellant's arguments are not persuasive, as Brown does not simply display all of the pieces once, as appellant suggests. The pieces are earned over time and *periodically* the overall image is displayed with the current number of earned pieces.

Appellant argues that there is no progressive display of an image or display of portions of the image as the "entire puzzle is displayed and the only thing that changes is the number of pieces, the number of pieces being determined by the number of stars."

In response, it is noted that the progressive earning of more pieces is what corresponds to the progressive display of portions of the image. While appellant states that the "entire puzzle is displayed", it is unclear what appellant refers to as appellant admits, on page 10 of the appeal brief, that the displayed number of pieces in the

puzzle changes. Thus, the "entire puzzle" is never displayed until the user has earned all of the pieces. Until that point, the user is limited to the number of pieces that have actually been earned. Periodically, more pieces are displayed as they are earned (Fig. 12A; paragraph 128).

Thus, for each periodic feedback display, the user will be displayed more and more of the overall image, as more individual pieces have been earned.

In response to appellant's arguments on page 10, concerning claim 16, see above. Furthermore, although not argued by appellant, it is noted that a typographical error lists the PNG specification. The rejection of claim 16, however, is not reliant upon the PNG specification, as it merely relies upon the addition of Bauminger to the previously cited references used in claim 15, which claim 16 depends upon.

#### **(11) Related Proceeding(s) Appendix**

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/James Sheleheda/

Primary Examiner, Art Unit 2424

**A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:**

/Timothy P Callahan/

Director, Technology Center 2400

Conferees:

/Christopher Kelley/

Supervisory Patent Examiner, Art Unit 2424

/John Miller/

Supervisory Patent Examiner, Art Unit 2421